

### **REMARKS**

The following remarks are made in response to the Non-Final Office Action mailed January 29, 2009. Claims 25-35 have been allowed. Claims 1-4, 6, 8-15, 18-22, 24 and 36-39 were rejected. Claims 5 and 7 have been objected to. With this Response, claims 5 and 7 have been amended. Claims 1-15, 18-22 and 24-39 remain pending in the application and are presented for reconsideration and allowance.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 103**

To establish a *prima facie* case of obviousness, each of these three criteria must be met: (1) there must be some suggestion or motivation to modify or combine the reference teachings; (2) there must exist a reasonable expectation of success; and (3) the references must teach or suggest all of the claim limitations. MPEP § 2143.

Patent Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. § 103. MPEP § 2141. The four *Graham* factual inquiries that provide the basis for an obviousness determination include: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations.

In addition, the Manual of Patent Examining Procedure at Section 2141 provides these basic tenants of patent law that must be adhered to:

- A. The claimed invention must be considered as a whole;
- B. The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- C. The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- D. Reasonable expectation of success is the standard with which obviousness is determined.

The U.S. Patent & Trademark Office has published guidelines, effective October 10, 2007, that will assist Office personnel in making a “proper determination of obviousness under 35 U.S.C. § 103.” Fed. Reg., Vol. 72, No. 195. The guidelines recognize that differences between the cited art and the claimed invention are likely to exist, and provides that “The gap between the prior art and the claimed invention may not be ‘so great as to render the [claim] nonobvious to one reasonably skilled in the art.’” *Dann v. Johnston*, 425 U.S. 219, 230, 189 USPQ 257, 261 (1976).

It is believed that the diverse collection of cited references include gaps in their respective disclosures that is so great that no basis exists for establishing a prima facie case of obviousness in light of the cited references.

Recently, the Supreme Court offered guidance on how references should be viewed when conducting an obviousness determination. The Supreme Court’s position is: “A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1731; 82 USPQ2d 1385, 1389 (2007)(*emphasis added*). In making this point, the Court

noted that “[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR*, 127 S. Ct. at 1738; 82 USPQ2d at 1396 (*emphasis added*).

In addition, the Court in the *KSR* decision offers this reminder: “A fact finder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” *KSR*, 127 S. Ct. at 1739; 82 USPQ2d at 1397 (citing to *Graham*, 38 U.S. 1, 36 in warning against a temptation to read into the prior art the teachings of the invention at issue and instructing courts to guard against slipping into the use of hindsight).

#### **Rejection of Claims 1-4, 6, 8-14, and 24**

Claims 1-4, 6, 12-14 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fima, U.S. Patent No. 4,250,650 in view of Treon, U.S. Patent No. 4,799,327 in view of Garr, U.S. Patent No. 4,727,674 and further in view of Bomann, U.S. Patent No. 6,393,757.

Claim 8 was rejected under 35 U.S.C. 103(a) as being unpatentable over Fima as modified by Treon, Garr and Bomann as applied to claim 4 above, and further in view of Liebert, U.S. Patent No. 3,952,445.

Claim 9 was rejected under 35 U.S.C. 103(a) as being unpatentable over Fima as modified by Treon, Garr and Bomann as applied to claim 4 above, and further in view of Ray, U.S. Patent No. 4,175,348.

Claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over Fima as modified by Treon, Garr and Bomann as applied to claim 4 above, and further in view of Malphrus, U.S. Patent No. 4,516,350.

Claim 11 was rejected under 35 U.S.C. 103(a) as being unpatentable over Fima as modified by Treon, Garr and Bomann as applied to claim 4 above, and further in view of West, U.S. Patent No. 6,581,319.

After acknowledging that the primary reference (Fima) does not disclose various aspects of the claimed invention, it is contended in the Office Action that it would have been obvious to combine individual features from each of the secondary references with the Fima fishing lure to produce the claimed invention.

In particular, the Office Action acknowledges that Fima does not disclose the following elements:

- (1) a light source as a linear bank of lights;
- (2) a circular bank of display lights in the housing aft of the first lights;
- (3) a jacket that is removable and interchangeable.

While the Applicants agree that the primary reference (Fima) does not disclose the above elements, Applicants respectfully dispute that the secondary references disclose the above elements, as they are recited in the present application. Additionally, it is respectfully submitted that other limitations of the claimed invention are not disclosed by Fima.

First, independent claims 1 and 24 include the limitations of a lure body including a housing with sidewalls made of a **generally light-transmissive material**. Fima, in view of Treon, Garr and Bomann do not teach or reasonably make obvious these limitations.

The Office Action cites to Fima with respect to the above limitations. However, Fima discloses body 12 and main section 20 made from a material that is not light transmissive. Fima further discloses light conductors which carry light to one or more locations on the exterior of the lure. (col. 1, lines 50-51) Fima discloses two bundles of light conducting optical fibers to direct light from light sources 38, 40 to simulated eyes 46 and tail 48. (See Figs. 1 and 3) As such, Fima teaches light conducting optical fibers directing the light from a light source to select exterior locations on the lure body, the eyes 46 and tail 48. Therefore, contrary to claims 1 and 24 wherein the lure body including a housing with sidewalls is made of a generally light-transmissive material, Fima teaches that only select locations such as the eyes and tail are light transmissive.

Second, independent claims 1 and 24 also include the limitations of a **first linear bank of display lights** installed in the housing parallel to an intended direction of travel of the lure through a body of water and including **a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls** of the housing. Fima, Treon, Garr and Bomann, either alone or in combination, do not teach or reasonably make obvious these limitations.

As acknowledged by the Examiner, Fima does not disclose the first light source as a linear bank of lights. In this respect the Examiner cites to Figure 1 of Treon. However, Treon discloses light source and distribution module X as an elongated tube 10. (See Fig. 1) Further, Treon discloses the bundle of optical fibers F provided to distribute light emitted from LED 32. (col. 3, line 66 to col. 4, line 1) As illustrated in Fig. 2 of Treon, only one LED 32 is disclosed. Treon discloses the manner in which the single light source is distributed within the lure to be

bundles 38, 39 and 40 of optical fibers extending from the single LED light source 32 and projecting out of the lure body. (col. 4, lines 1-35, see also Figs. 2, 4 and 5) Further, Treon discloses bundle 38 extending to the dorsal area, bundle 39 extending to the ventral area, and bundle 40 extending to the tail area. (col. 4, lines 13-28, see also Fig. 1) As illustrated in Fig. 1, these areas are not linear, but instead include the top, bottom and end of the lure. In this manner, Treon does not teach or suggest the limitations a first linear bank of display lights installed in the housing parallel to an intended direction of travel of the lure through a body of water and including a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls of the housing as recited in claims 1 and 24.

Third, independent claims 1 and 24 include the limitations of a circular bank of display lights installed **in the housing aft of the first linear bank of lights** and including a plurality of spaced apart, **aft facing individual electric light sources**. Fima, Treon, Garr and Bomann, either alone or in combination, do not teach or reasonably make obvious these limitations.

The Office Action cites to the light emergence points 3 of Garr for the above limitations. Initially, Garr discloses a light source contained in the body of the lure and light brought to the surface by fiber optics. (Abstract) Garr further discloses the light emerging from the ends of optionally faceted fiber optics or external LED's at 3. (col. 4, lines 44-46) Additionally, Garr discloses light is fed in four 90° quadrants from the mid body of the lure and one acrylic light pipe or fiber optic extended out the end of the lure. (col. 5, lines 21-23, 32-35, 45-47, and 57-59) As illustrated in Figs. 1-2 of Garr, the light emergences points 3 are placed in two sections of quadrants at the mid body. In this manner, Garr teaches light emergence points 3 placed in two sections of light emergence points placed at 90° intervals around the mid body of the lure, one

section aft of the other, and one singular light emergence point 3 at the aft end of the lure. This is unlike the circular bank of display lights installed in the housing aft of the first linear bank of lights as recited in claims 1 and 24.

Further, Garr discloses light emergence points 3 and external LED's 24 extending directly outward from the end of the light pipes and interior of the lure. (See Figs. 1-3) Unlike the aft facing light sources of claim 1, Garr discloses the light pipes extend radially from the interior of the lure to the exterior of the lure. (See Figs. 3 and 9) As such, Garr does not teach a plurality of spaced apart, aft facing individual electric light sources as recited in claims 1 and 24.

In sum, the combination of Fima, in view of Treon, in view of Garr, in further view of Bomann, as applied to claims 1 and 24 do not teach or reasonably make obvious the above limitations. It is respectfully submitted that the cited art fails to teach or reasonably make obvious at least these features recited by claims 1 and 24. Thus, claims 1 and 24 recite allowable subject matter.

Additionally, the Examiner fails to cite any motivation to modify Fima to include the above noted limitations, notably, a linear bank of display lights. Fima relates to a fishing lure in which light sources are internally mounted for protection by the body of the lure and the light is transmitted to exterior locations by optical conductors. (Abstract) The background of Fima discusses that the disadvantages to be overcome include awkward or unnatural overall appearance of fishing lures. (col. 1, lines 16-21) Light conductors carry the light to simulated eyes 46 and tail 48 on the exterior of the lure from the two light sources 38/40. (col. 1, lines 51-52; Figs. 1 and 3) In contrast, the linear bank of display lights of claims 1 and 24 is not comprised of two light sources transmitted to simulated eyes and tail on the exterior by optical

conductors, but include a plurality of individual electric light sources viewable through light transmissive material sidewalls of the housing. Thus, Fima teaches away from the modifications advanced by the Examiner. Without a requisite motivation to modify, it is respectfully submitted that the Examiner's rejection of claims 1 and 24 is traversed, and withdrawal of that rejection is respectfully requested.

Claims 2-4, 6, and 12-14 further define patentably distinct independent claim 1. As previously described, the combination of Fima, in view of Treon, in view of Garr, in further view of Bomann, as applied to claims 1 and 24 do not teach or reasonably make obvious the above limitations. Thus, claims 1-4, 6, 12-14 and 24 are believed to be allowable over the cited prior art.

Claims 8-11 were rejected based upon additional references. For the reasons set forth in previous responses and above with respect to claim 1 which these claims further define, it is submitted that claims 8-11 are also non-obvious when viewed in light of the cited references, as none of the additional references overcome the deficiencies discussed above. Therefore, these claims are also believed to be allowable over the cited prior art.

Reconsideration and withdrawal of the rejections of claim 1-4, 6, 8-14 and 24 are respectfully requested.

#### **Rejection of Claims 15 and 18-22**

Claims 15 and 18- 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fima in view of Garr and Bomann.



Claim 20 was rejected under 35 U.S.C. 103(a) as being unpatentable over Fima as modified by Garr and Bomann as applied to claim 19 above, and further in view of Liebert, U.S. Patent No. 3,952,445.

Claim 21 was rejected under 35 U.S.C. 103(a) as being unpatentable over Fima as modified by Garr and Bomann as applied to claim 20 above, and further in view of Ray, U.S. Patent No. 4,175,348.

Claim 22 was rejected under 35 U.S.C. 103(a) as being unpatentable over Fima as modified by Garr, Bomann and Liebert as applied to claim 20 above, and further in view of Malphrus, U.S. Patent No. 4,516,350.

Independent claim 15 includes the limitations of a circular bank of display lights installed in the housing circularly disposed about an axis parallel to an intended direction of travel of the lure through a body of water and including a plurality of spaced apart, aft facing individual electric light sources. Fima in view of Garr and Bomann do not teach or reasonably make obvious these limitations.

Similar to independent claims 1 and 24 discussed above, the Examiner cites to the light emergence points 3 of Garr for the above limitations. For at least the reasons noted above with respect to claims 1 and 24, Fima as modified by Garr does not disclose or reasonably make obvious at least these limitations. As such, independent claim 15 is also believed to be allowable over the cited references.

Additionally, independent claim 15 includes the limitations of an electronic flasher module connected to said light bank operative to **sequentially flash the light sources** of the light

bank on and off for the purpose of attracting fish. Fima in view of Garr and Bomann do not teach or reasonably make obvious these limitations.

The Examiner contends that Fima as modified by Garr disclose the above limitations and specifically cites to Fima. However, Fima discloses:

a circuit that powers the parallel light sources 38 and 40 is completed only when both battery terminals 52 and 54 are simultaneously in engagement with stationary contacts 34. The lights sources are, therefore, energized intermittently as the battery 50 rolls back and forth within the guideway 24 under the force of gravity due to the rocking action of the lure 10. (emphasis added)

In this manner, Fima teaches that light sources 38 and 40 are energized together, at the same time, as they are connected in parallel. Further, Fima teaches that the light sources are either energized or not energized simultaneously, in response to the battery 50 intermittent electrical connections. Further, unlike the limitations of claim 15 in which an electronic flasher module is connect to said light bank, Fima discloses that the battery is only intermittently connected to the light sources 38 and 40 as the battery 50 rolls back and forth. As such, Fima as modified by Garr does not disclose or reasonably make obvious the above limitations.

In sum, the combination of Fima in view of Garr and Bomann, as applied to claim 15 do not teach or reasonably make obvious the above limitations. Thus, independent claim 15 recites allowable subject matter. Claims 18-22 further define patentably distinct independent claim 15. Therefore, these claims are also believed allowable over the cited prior art. As such, reconsideration and allowance of claims 15 and 18-22 is respectfully requested.

**Rejection of Claims 36-37 and 39**

Claims 36-37 and 39 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fima in view of King et al., U.S. Patent No. 6,647,659.

Claim 38 was rejected under 35 U.S.C. 103(a) as being unpatentable over Fima as modified by King et al. as applied to claim 37 above, and further in view of Ray, U.S. Patent No. 4,175,348.

Independent claim 36 includes the limitations of a leader tube, passing centrally through the body to the battery pack, that form part of a recharging circuit, wherein a leader wire is extendable through the leader wire. Fima in view of King, either alone or in combination, do not teach or suggest these limitations.

The Examiner cites to King with respect to the above limitations. As discussed in previous responses, King does not disclose a leader tube. Reference numeral 35 in King is for a switch housing in which metal ball bearing 37 moves. As is discussed and illustrated in the present application and as is common knowledge to those of ordinary skill in this field, a leader tube is adapted to receive a leader wire.

Accordingly, it is submitted that the Examiner has failed to make a prima facie showing of obviousness for claim 36 or claims 37-39, which depend from claim 36. Reconsideration and withdrawal of this rejection are respectfully requested.

**Allowable Subject Matter**

The Examiner objected to claims 5 and 7 for being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims.

Applicants agree with the Examiner's conclusions regarding patentability without necessarily agreeing with or acquiescing in the Examiner's reasoning. In particular, Applicants believe that the claims are allowable because prior art fail to teach, anticipate, or render obvious the invention as claimed, independent of how the invention is paraphrased. Therefore, dependent claims 5 and 7 have been rewritten in independent form to include the limitations of previously presented claim 1 and intervening claims. Accordingly, applicants believe that dependent claims 5 and 7 are allowable over the cited references. Allowance of claims 5 and 7 is respectfully requested.

### **CONCLUSION**

In view of the above, Applicant respectfully submits that pending claims 1-15, 18-22 and 24-39 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-15, 18-22 and 24-39 are respectfully requested.

Applicants hereby authorize the Commissioner for Patents to charge Deposit Account No. 50-0471 in the amount of \$220.00 to cover the fees as set forth under 37 C.F.R. 1.16(h).

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to Michael A. Bondi at Telephone No. (612) 767-2512, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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